



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/614,056 | 07/08/2003 | Takeshi Ando | Q76455 | 7511 |

23373 7590 10/20/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

HUYNH, CHUCK

ART UNIT PAPER NUMBER

2683

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,056

Applicant(s)

ANDO, TAKESHI

Examiner

Chuck Huynh

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/28/2005 have been fully considered but they are not persuasive.

The invention in claim 1 appears to be combining the ability to provide a caller with registration information of a called party (disclosed by Toy) within an international roaming service environment (when a called party moved from a first country to a second country) (disclosed by Toy in view of Okoro).

Regarding claim 1, Applicant argues that Toy fails to disclose, teach or suggest a storing information unit, which stores the registration status of a mobile station, as recited in claim 1, and that Toy is completely silent regarding the registration of a mobile station as a visitor. Examiner disagrees and would like to explain that Toy does disclose the ability to provide information from a database (Col 1, line 47), which entails not just a user's location status, but also registration status (Col 2, lines 19-22). In the field of mobile roaming service, Toy discloses a roamer's registration status is suggested to be from their basic service area (which is known in the art as a home network) to another outside network (which is known in the art as a visitor network) (Col 1, lines 29-32). Toy does suggest that the invention is adequate for the Continental United States and also for International Networks for places like Europe (Col 2, lines 5-12). Furthermore, Okoro discloses an international roaming service for permitting a cellular telephone instrument

Art Unit: 2683

to access different wireless networks (Col 3, line 61 - Col 4, line14; Col 4, lines 49-53); therefore, it would have been obvious to one ordinarily skilled in the art at the time of invention to combine Toy's disclosure with Okoro to provide international (country to country) registration information for caller of called party to establish calling charges.

Dependent claims 2-16 remain rejected below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy et al. (hereinafter Toy) in view of Okoro et al. (hereinafter Okoro).

Regarding claim 1, Toy discloses a notification system for notifying information about a mobile station capable of using international roaming service (Abstract; Col 2, lines 9-10), comprising:

an information storing unit (databases Fig.1 , nos. 22,23) that stores information about a mobile station which belongs to a first network in a first country, said information including a fact whether said mobile station is moved to a second country and

registered as a visitor station in said second country or not (Col 1, lines 41-53; Col 2, lines 1-26; Col 3, lines 51-52));

a notification unit (Col 3, lines 53-58) that refers to said information storing unit when said mobile station is called by a caller terminal within said first network to detect whether said mobile station is registered as said visitor station in said second country or not, and notifies said caller terminal of the registration of said mobile station before a connection between said caller terminal¹⁵ and said mobile station is established, when said mobile station is registered as said visitor station in said second country (Col 2, lines 16-26).

Toy discloses all the particulars of the claim, but was unclear on the international roaming aspect.

However, Okoro does disclose international roaming services (Col 4, lines 49-53).

It would have been obvious to one ordinarily skilled in the art at the time of invention to combine Toy's disclosure with Okoro to provide international (country to country) registration information for caller of called party to establish calling charges.

Regarding claim 2, Toy discloses a notification system as set forth in Claim 1, further comprising a calculating unit that calculates telephone fee charged to said caller terminal when said connection between said caller terminal and said mobile station registered as said visitor station in said second country is established, wherein said notification unit notifies said caller terminal of the telephone fee calculated by said

Art Unit: 2683

accounting unit in addition to said registration before said connection between said caller terminal and said mobile station is established, when said mobile station 10 is registered as a visitor station in said second country (Abstract; Col 1, lines 41-53; Col 2, lines 1-15).

Regarding claim 3, Toy disclose a notification system as set forth in Claim 1, further comprising:

a location obtaining unit that obtains location of said mobile station (Col 2, lines 16-26);

a visitor registration unit that registers said mobile station as a visitor station in said second country to have said mobile station capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests for the registration (Col 2, lines 16-26); and

a reporting unit that reports said registration of said mobile station to said location obtaining unit, wherein said location obtaining unit stores information about said registration of said mobile station in said information storing unit (Col 2, lines 16-26; Col 5, lines 37-40).

Regarding claim 4, Toy discloses a notification system as set forth in claim 2 further comprising:

a location obtaining unit that obtains location of said mobile station (Col 2, lines 16-26);

a visitor registration unit that registers said mobile station as a visitor station in said second country to have said mobile station capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests for the registration (Col 2, lines 16-26); and

a reporting unit that reports said registration of said mobile station to said location obtaining unit, wherein said location obtaining unit stores information about said registration of said mobile station in said information storing unit (Col 2, lines 16-26; Col 5, lines 37-40).

Regarding claim 5, Toy discloses a notification system as set forth in claim 3, wherein said visitor registration unit deletes said registration of said mobile station as said visitor station upon receiving request from said mobile station, said reporting unit reports said deletion of said registration of said mobile station to said location obtaining unit, and said location obtaining unit deletes said information about said registration information in said information storing unit (Col 2, lines 16-38).

Regarding claim 6, Toy discloses a notification system as set forth in claim 4, wherein said visitor registration unit deletes said registration of said mobile station as said visitor station upon receiving request from said mobile station, said reporting unit reports said deletion of said registration of said mobile station to said location obtaining unit, and said location obtaining unit deletes said information about said registration information in said information storing unit (Col 2, lines 16-38).

Regarding claim 7, Toy discloses a notification system as set forth in claim 1, further comprising an accounting unit that charges paid caller terminal for notification of said notification unit (Col 2, lines 56-59).

Regarding claim 8, Toy discloses a notification system as set forth in Claim 2, further comprising an accounting unit that charges said caller terminal for notification of said notification unit (Col 2, lines 56-59).

3. Claim 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy in view of Okoro in further view of Dunn.

Regarding claim 9, Toy in view of Okoro discloses all the particulars of the claim except for a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country (Abstract; Col 2, lines 18-30; Col 3, lines 43-45, 49-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Dunn's feature with Toy to provide users with more information options.

Regarding claim 10, Toy in view of Okoro discloses all the particulars of the claim except for a notification system as set forth in claim 2, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country (Abstract; Col 2, lines 18-30; Col 3, lines 43-45, 49-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Dunn's feature with Toy to provide users with more information options.

4. Claim 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy in view of Okoro in further view of Asano et al. (hereinafter Asano).

Regarding claim 11, Toy in view of Okoro discloses all the particulars of the claim except a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station.

However, Asano does disclose a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station (Col 5, lines 64-67; Col 6, lines 1-13).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate a translation unit to facilitate communication between different language users.

Regarding claim 12, Toy in view of Okoro discloses all the particulars of the claim except a notification system as set forth in claim 2, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station.

However, Asano et al. (hereinafter Asano) does disclose a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station (Col 5, lines 64-67; Col 6, lines 1-13).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate a translation unit to facilitate communication between different language users.

5. Claim 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy in view of Okoro in further view of Dunn.

Regarding claim 13, Toy in view of Okoro does hint but may be unclear about a notification system as set forth in claim 1, further comprising a retaining unit that temporary retains establishing a connection between said caller terminal and said mobile station (Col 3, lines 58-61).

However, Dunn does clearly disclose a notification system as set forth in claim 1, further comprising a retaining unit that temporary retains establishing a connection between said caller terminal and said mobile station (Col 3, lines 56-62).

It would have been obvious to one ordinarily skilled in the art at the time of invention to retain connection while the user select options for the call so the user does not have to terminate the call and enter a series of numbers.

Regarding claim 14, Toy in view of Okoro does hint but may be unclear about a notification system as set forth in claim 2, further comprising a retaining unit that temporary retains establishing a connection between said caller terminal and said mobile station (Col 3, lines 58-61).

However, Dunn does clearly disclose a notification system as set forth in claim 1, further comprising a retaining unit that temporary retains establishing a connection between said caller terminal and said mobile station (Col 3, lines 56-62).

It would have been obvious to one ordinarily skilled in the art at the time of invention to retain connection while the user select options for the call so the user does not have to terminate the call and enter a series of numbers.

Regarding claim 15, Toy in view of Okoro discloses all the particulars of the claim except for a notification system as set forth in claim 1, further comprising a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode (communication when the called party is present) to a mail (voicemail) sending mode upon receiving a request from said caller terminal.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a mail (voicemail) sending mode upon receiving a request from said caller terminal (Col 1, lines 24-25; Col 5, lines 47-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to be able to send voicemail or messages instead of talking to the called party due to expensive rates.

Regarding claim 16, Toy in view of Okoro discloses all the particulars of the claim except for a notification system as set forth in claim 2, further comprising a mode changing unit that changes mode of a connection between said caller terminal and said

Art Unit: 2683

mobile station from a conversation mode (communication when the called party is present) to a mail (voicemail) sending mode upon receiving a request from said caller terminal.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a mail (voicemail) sending mode upon receiving a request from said caller terminal (Col 1, lines 24-25; Col 5, lines 47-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to be able to send voicemail or messages instead of talking to the called party due to expensive rates.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Adamany; Robert Andrew discloses Methods and systems for providing information to a home system regarding a wireless unit roaming in a visited system

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Huynh whose telephone number is 571-272-7866. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/614,056

Page 14

Art Unit: 2683

Chuck Huynh


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600